

REMARKS

In response to the final Office Action mailed June 27, 2005, the present application has been carefully reviewed and amended. In conjunction with the accompanying declaration under 37 CFR 1.131, Applicant respectfully requests entry of the present amendment and reconsideration of the application.

Claim Rejections 35 USC §102

Claims 1, 5, 7, 9, 13-18, 20-30 and 40-50 stand rejected under 35 USC §102(e) as being anticipated by WO 2004/108458.

Applicant submits herewith a Declaration by the inventors David T. Zwolinski and Kevin R. Willett under 37 CFR §1.131 establishing conception of the subject matter of the rejected claims prior to the effective date of WO 2004/108458 and diligent efforts to a reduction to practice by the filing of the present application on October 17, 2003. Applicant respectfully submits the showing of facts are of such character and weight as to establish conception of the invention prior to the effective date of WO 2004/108458 (June 4, 2003) coupled with due diligence from prior to said date to a subsequent filing of the present application (October 17, 2003). Therefore, Applicant respectfully requests the rejections in view of WO 2004/108458 be withdrawn.

Claim Rejections 35 USC §103*Claims 2-4 and 10-12*

Claims 2-4 and 10-12 stand rejected under 35 USC §103 as being unpatentable over WO 2004/108458.

In view of the accompanying declaration under 37 C.F.R. 1.131, applicant submits the present rejection cannot be sustained.

Claim 19

Claim 19 stands rejected under 35 USC §103 as being unpatentable over WO 2004/108458 in view of Keeney et. al.

In view of the accompanying declaration under 37 C.F.R. 1.131, applicant submits the present rejection cannot be sustained.

Claims 1, 5, 6 and 24

Claims 1, 5, 6 and 24 stand rejected under 35 USC §103 as being unpatentable over European Patent Publication No. 0 367 731 (EP '731) in view of Keeney (US 6,189,198). The examiner relies upon Keeney to disclose a polymeric backbone 68, referencing Col. 3, lines 40-45.

The examiner asserts "it would have been obvious to provide European Patent Publication No. 0 367 731 with a polymeric backbone, as taught by Keeney et al., to make the weatherseal *more readily bendable*. [Paper 20050614, page 6] [emphasis added]

Claims 1, 5, 6 and 24 recite in part, "a rigid polymeric backbone." In contrast, the cited references are relied upon to provide a weatherseal that is "more readily bendable."

Therefore, as the asserted references are directly contrary to the present claims, applicant respectfully submits the present rejection cannot be sustained.

To establish a *prima facie* case of obviousness, Denso must show "some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." *Fine*, 837 F.2d at 1074, 5 USPQ2d at 1598. There is no suggestion to combine, however, if a reference teaches away from its combination with another source. *See id.* at 1075, 5 USPQ2d at 1599. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. . . [or] if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 27 F.3d 551, 553, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). If when combined, the references "would produce a seemingly inoperative device," then they teach away from their combination. *In re Spinnoble*, 405 F.2d 578, 587, 160 USPQ 237, 244 (CCPA 1969); *see also In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) (finding no suggestion to modify a prior art device where the modification would render the device inoperative for its

intended purpose). *Tec Air Inc. v. Denso Manufacturing Michigan Inc.* (CA FC) 52 USPQ2d 1294, 1298.

Therefore, as the references are deemed to suggest combination for a more readily bendable weatherseal, and the claims recite a "rigid" backbone, the present rejection cannot be sustained.

In addition, applicant respectfully submits Keeney does not disclose a weatherseal comprising a polymeric backbone 68.


The carrier 68 is formed from a flat sheet material 70 provided by a woven wire 72. The wire 72 is woven in a serpentine manner. Interwoven into the wire 72 are fiber warps 74. The warps 74 are typically made from polypropylene or polyethylene. 45 (Col. 3)

That is, the Keeney carrier 68 is a serpentine wire having polypropylene or polyethylene warps. Applicant acknowledges that the polypropylene or polyethylene are certainly polymeric materials. However, the strength of the carrier is provided by the wire 72. In fact, Keeney heats the warp fibers 74 to break down the fibers so that the seal is readily bendable.

Therefore, the asserted rejections in view of EP '371 and Keeney cannot be sustained.

Applicant respectfully submits all the pending claims, Claims 1-30 and 40-50, are in condition for allowance; and such action is earnestly solicited. If, however, the examiner believes that any further issues remain, he is cordially invited to contact the undersigned so that such matter can be promptly resolved.

Respectfully submitted,



Brian B. Shaw, Registration No. 33,782
HARTER, SECREST & EMERY LLP
1600 Bausch & Lomb Place
Rochester, New York 14604
Telephone: 585-232-6500
Fax: 585-232-2152

Date: September 19, 2005